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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,027	10/17/2001	Guenaelle Martin	214862US0	3816
22850	7590	03/28/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	
DATE MAILED: 03/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,027

Applicant(s)

MARTIN ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 17, 2004 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding (US 5705144) in view of Forestier et al. (US 5302376) ("Forestier").

Harding teaches a cosmetic composition comprising retinoid and a dioc acid. See abstract. The reference teaches "co-formulation with a sunscreen enhances the photo-stability and activity of retinal or its derivative within the formulation and also prevent further actinic damage to all epidermal cells". See col. 2, lines 51 – 62. The reference teaches using 0.5 – 5 % by weight of the retinoid. See col. 3, lines 10 – 14; instant claim 3. See col. 6, line 45 – col. 8, line 11 for useful sunscreens including Benzophenone –3, octyl salicylate, octyl methoxy-cinnamate. See instant claims 6-10.

Harding fails to teach benzene-1, 4-bis (3-methyldiene-10-camphorsulphonic acid).

Forestier teaches a cosmetic emulsion comprising benzene-1, 4-bis (3-methyldiene-10-camphorsulphonic acid) as the active UV screening agent. See abstract. The reference teaches using 0.1-10 % of the UV screening agent by weight of the emulsion. See col. 3, line 61 – col. 4, line 5; instant claim 4. The reference teaches o/w emulsion. See col. 4, lines 6 – 10; instant claim 5. The reference teaches that the screening agent provides sufficient screening for sensitive skin, and produces high sun-protection at low concentration. See col. 2, lines 2, and lines 1 – 24. The reference also teaches that the composition is advantageous in that it is thermally and photochemically stable, not toxic and harmless to the skin. See col. 2, lines 64 – 68. Examiner views that the recited stability of retinoid is a resulting physical property of the obvious variation of the prior arts. Neither Harding or Forestier teaches using histidine in the compositions. See instant claims 17 and 18.

Given the general teaching of stabilizing retinoid by adding sunscreen agent in Harding, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior art such as Forestier for specific sun screening agent. The skilled artisan would have been motivated to modify the composition of Harding by adding benzene-1, 4-bis (3-methyldiene-10-camphorsulphonic acid) as taught by Forestier because of an expectation of successfully producing a stable retinoid composition. The motivation to add the specific sun screening agent is found in the teachings of the Harding reference and particularly in Forestier reference which teaches that the camphor derivatives exhibits high sun-

2. Claims 1-10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boussouira (EP 2779060) in view of Forestier et al. (US 5302376) ("Forestier").

Boussouira teaches a cosmetic composition comprising retinol and histidine. See abstract; English equivalent (US 6358514 B1). The reference teaches that it is well known in the art to add sunscreen agent "to reinforce the stability" of the retinoid-polyamino polymer combination by "limiting the harmful action of UV on the retinoid". See instant claim 16. The reference teaches using camphor derivatives among other sunscreens, and particularly mentions benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid), which meets formula (I) of instant claims. See Boussouira, p. 8, line 35 – p. 9, line 19; '514 patent, p. 7, line 52 – col. 8, line 13. The reference teaches using 0.0001 – 10 % by weight of retinoid. See Boussouira, p. 9, line 38 – p. 10, line 3; '514 patent, col. 8, lines 36 – 43. The reference also teaches o/w emulsion form of the invention. See Boussouira, Example 2. The reference teaches the claimed method of treating and preventing photoinduced aging skin by applying a composition comprising retinoid. See Boussouira, p. 1, lines 2 – 35; '514 patent, col. 1, lines 17 – 44. The reference further teaches adding additional sunscreen to reinforce the stability of the retinoic with the polyamino polymer by limiting the harmful action of UV on the retinoid. See col. 7, lines 52 – col. 8, line 13. 2-ethylhexyl p-methoxycinnamate, salicylic derivatives, triazine derivatives, and 2-hydroxy-4-methoxybenzophenone are taught. See instant claims 6-10.

The reference fails to teach the amount of benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid) to be used in the composition.

Forestier teaches a cosmetic emulsion comprising benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid) as the active UV screening agent. See abstract. The reference teaches using 0.1-10 % of the UV screening agent by weight of the emulsion. See col. 3, line 61 – col. 4, line 5; instant claim 4. The reference teaches o/w emulsion. See col. 4, lines 6 – 10; instant claim 5. The reference teaches that the screening agent provides sufficient screening for sensitive skin, and produces high sun-protection at low concentration. See col. 2, lines 2, and lines 1 – 24. The reference also teaches that the composition is advantageous in that it is thermally and photochemically stable, not toxic and harmless to the skin. See col. 2, lines 64 – 68. Examiner views that the recited stability of retinoid is a resulting physical property of the obvious variation of the prior arts.

Given the general teaching of stabilizing retinoid by adding sunscreen agent in Boussouira, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior art such as Forestier for specific sun screening agent and the amount to use. It would have been obvious to the skilled artisan to formulate the Boussouira composition by using 0.1-10 % of benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid) as motivated by Forestier because a) both references teaches using the same UV screening agent in topical o/w emulsions; and b) Forestier teaches that the camphosulphonic acid derivative provides high sun-protection

at low concentration, and photochemical and thermal stability, and is suitable for sensitive skin.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are unpersuasive in part and moot in view of the ground of new rejections.

Applicants' arguments regarding the anticipatory rejection made over Boussouira is moot in view of the claim amendment made by applicants.

Regarding the rejection made under 35 U.S.C. § 103 (a) over Harding (US 5705144) in view of Forestier et al. (US 5302376), applicants assert that Harding fails to teach, suggests or recognizes that UVA sunscreens can degrade retinol. However, the basis of the present invention is whether the claimed composition and method is novel or nonobvious over the prior arts; rather than what the prior arts failed to recognize. In this case, the collective teachings of the reference provide sufficient motivation to combine retinol and the camphorsulphonic acid derivative specifically to stabilize retinol with the UV screening agent. In this case, the motivation to combine the references is found as the Harding reference specifically teaches to use retinol with a sunscreen to "enhance the photo-stability or its derivative", and the Forestier reference teaches the photostability of the specific camphorsulphonic sunscreen compound. Rejection is thus viewed proper.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gina Yu
Patent Examiner


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER